

REMARKS

Reconsideration and allowance of this application in light of the foregoing amendments and accompanying remarks is respectfully requested.

TELEPHONE INTERVIEW WITH THE EXAMINER

On September 3, 2003, the applicant's attorney had a telephone call with the Examiner regarding the checked box "b" in Item 13 of the Office Action Summary. The Examiner told the attorney that the Examiner may have checked the wrong box, and that the attorney should ignore it for the time being.

FURTHER INFORMATION REQUESTED FROM EXAMINER

The Examiner is requested to advise what priority document certified copies, if any, have not been received as noted in the Office Action Summary Item 13.

THE REJECTION OF CLAIMS 12-14, 18, 21, 25, 30-32, 34, 35, 39, 45, AND 48 IS OVERCOME

Claims 12-14, 18, 21, 25, 30-32, 34, 35, 39, 45, and 48 were rejected under 35 U.S.C. §103 as being unpatentable over a combination of three (3) documents: the U.S. Patent No. 4,684,909 (to Berg et al.), U.S. Patent No. 4,919,482 (to Tyler et al.), and WO 95/20066 (to Leithem).

It is respectfully submitted that the subject matter of the rejected claims is not obvious in view of the combination of the cited references. It is believed that when the present invention and the cited references are properly considered, it will become evident (as shown in the following discussion) that the teachings of these references do not

disclose or suggest the novel article of the present invention as claimed. Therefore, the rejections are traversed and should be withdrawn.

Claim 12, the only independent claim under examination at this time, sets forth, inter alia, a weight percent range of superabsorbent material between about 10 and about 60, and also sets forth a suppleness of greater than about  $0.7 \text{ g}^{-1}$ .

The Leithem patent cited by the Examiner does not teach or suggest the superabsorbent material weight percent range or the suppleness as claimed.

Claim 12 further sets forth, inter alia, a relative crystallinity of less than about 65%. The Berg patent, cited by the Examiner in combination with Leithem and Tyler, does not appear to teach or suggest such a relative crystallinity, and Berg, like Leithem as discussed above, also does not set forth the claimed suppleness.

The Tyler patent, which has been combined by the Examiner with the other two patents, also fails to teach, inter alia, the suppleness as claimed in independent claim 12.

An attempt to combine the various teachings of the cited patents fails, under the proper obviousness analysis, to teach or suggest the novel structure set forth in independent claim 12 in the instant application.

#### The Combination Of References Is Not Effective To Teach The Invention

#### ----The References Are Not Properly Combinable

The Examiner's combination of the above-discussed references is not well taken.

Attention is invited to Winner International Royalty Corp. v. Wang, 202 F.3d 1340, 1348 (Fed. Cir. 2000) where the court stated that "When an obviousness determination is based on multiple prior art references, there must be a showing of some "teaching, suggestion, or reason" to combine the references. Gambro Lundia AB v. Baxter Healthcare Corp., 110 F.3d 1573, 1579, 42 U.S.P.Q. 2d 1378, 1383 (Fed. Cir. 1997) (also noting that the "absence of such a suggestion to combine is dispositive in an obviousness determination")."

Further, the court in Winner stated, at 202 F.3d 1348-49, "...the showing of combinability, in whatever form, must nevertheless be 'clear and particular'."

Also, attention is directed to the court's guidance set forth in In re Lee, 277 F.3d 1338, 1343, 61 U.S.P.Q. 2d 1430, 1433 (Fed. Cir. 2002):

"When patentability turns on the question of obviousness, the search for and analysis of the question of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness."

In the instant situation, the prior art teaches away from providing the novel structure set forth in independent claim 12 of the instant application. For example, in the instant invention as set forth in claim 12 of the instant application, the absorbent material has a relatively high density from about 0.25 to about 0.5 g/cc and yet also has a relatively high suppleness value. In contrast, the Berg patent cited by the Examiner

tends to show that increasing density would normally be expected by one of ordinary skill in the art to lead to a decrease in suppleness. This would lead one of ordinary skill in the art away from attempting to combine the teaching of Berg with the other patents so as to somehow suggest the structure with the unique set of parameters as set forth in the instant application independent claim 12. Without any such teaching, suggestion, or acknowledgment of such a possibility, there would not have been an incentive for one of ordinary skill in the art to combine the cited references.

----The References Must Not Be  
Improperly Combined Using Hindsight

It would only be hindsight that would allow the Examiner to present any argument at all in rejecting the amended independent claim 12 of the instant application. As stated in In re Dembiczak, 175 F.3s 994, 999, 50 U.S.P.Q. 2d 1614, 1617 (Fed. Cir. 1998):

“Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for showing of the teaching or motivation to combine prior art references....Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.”

----Even If The References Are Combined, The Combination  
Does Not Teach Or Suggest The Present Invention

It is important to keep in mind the proper approach when attempting to combine references which teach one or more of the specific components in an overall structure. As articulated by the Court of Appeals for the Federal Circuit in Interconnect Planning Corp. v. Feil, 227 U.S.P.Q. 543, 548 (Fed. Cir. 1985), it is legal error to reconstruct the claimed system using the blueprint of the claims to pick and choose among the prior art. One must look to the overall arrangement and features of the claimed system.

In this case, none of the cited patents teaches or suggests, either alone or in combination, the claimed invention wherein the material has the claimed unique set of properties and structure, and none of the cited prior art patent structures suggests the claimed structure and resulting advantages.

--The Claims 13, 14, 18, 21, 25, 30-32, 34, 35, 39, 45, and 48 Are Allowable

In view of the above discussion, it is believed that independent claim 12 is allowable. Accordingly, withdrawal of the rejection of claim 12 is respectfully requested.

The dependent claims 13, 14, 18, 21, 25, 30-32, 34, 35, 39, 45, and 48 are each dependent directly or indirectly upon the above-discussed independent claim 12. Therefore, each dependent claim includes all of the features of the independent claim 12 from which it depends.

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For for the reasons given above in arguing for the allowability of independent claim 12, the dependent claims are believed to be allowable also. Therefore, withdrawal of the rejections of the dependent is also respectfully requested.

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It is believed that all of the claims in the application, as amended, are now in condition for allowance, and such action is earnestly solicited.

Further, it is believed that this entire application is now in condition for allowance, and such action is respectfully requested.

Respectfully submitted,

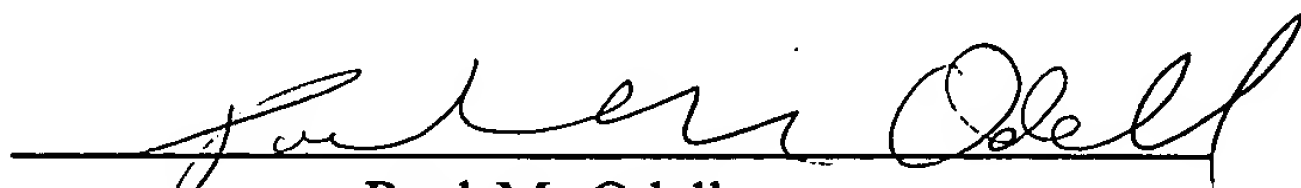
WOOD, PHILLIPS, KATZ, CLARK & MORTIMER

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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with sufficient postage as First Class Mail in an envelope addressed to Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450, on December 22, 2003.

  
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